

Inventor: William D. Huse
Serial No.: 09/997,209
Filed: November 28, 2001
Page 2

- Group IV : Claims 14-24, drawn to a cell composition;
- Group V : Claim 25, drawn to a method identifying a binding ligand;
- Group VI : Claims 26 and 27, drawn to a method of identifying a binding ligand;
- Group VII : Claims 28-36, drawn to a cell composition with heterologous nucleic acid;
- Group VIII: Claims 37 and 38, drawn to a method of identifying a ligand;
- Group IX : Claim 39, drawn to a method of identifying a polypeptide receptor for a ligand; and
- Group X : Claim 40, drawn to a method of identifying a functional polypeptide fragment.

The Examiner requests that one of the groups of claims be elected for examination. Although the restriction requirement is traversed for the reasons set forth below, Applicants elect the claims of Group I, claims 1-10, for examination.

Inventor: William D. Huse
Serial No.: 09/997,209
Filed: November 28, 2001
Page 3

The Restriction Requirement is traversed with respect to the division of the claims of Group I from the claims of Group IV. While the claims of Groups I and IV are patentably distinct, it is submitted that a thorough search of the claims of either group will likely reveal art relevant to the examination of the claims of the other groups. It is noted that no indication is given that these claims fall within different classes. The claims of Groups I and IV are directed to cell compositions comprising a population of non-yeast eukaryotic cells containing a diverse population of about 10 or more variant nucleic acids. A search of the claims of Group I will, of necessity, reveal information relevant to the examination of the claims of Group IV and, therefore, division of the claims into these groups would result in duplicative searches.

Furthermore, the division of the claims of Group I from the claims of Groups II and III is respectfully traversed. The claims of Groups II and III are directed to a method of identifying a polypeptide exhibiting optimized activity and a method of identifying a binding ligand, respectively, using the cell compositions of Group I. Thus, a search of the claims of Group I will, of necessity, reveal information relevant to the examination of the claims of Groups II and III and, therefore, division of the claims into these groups would result in duplicative searches. Similarly, the division of the claims of Group IV from the claims of Groups V and VI is respectfully traversed. The claims of Groups V and VI are directed to methods using the cell compositions of Group IV. Thus, a search of the claims of Group IV will, of necessity, reveal information

Inventor: William D. Huse
Serial No.: 09/997,209
Filed: November 28, 2001
Page 4

relevant to the examination of the claims of Groups V and VI and, therefore, division of the claims into these groups would result in duplicative searches. Accordingly, it is respectfully submitted that a search of these claims together would not be an undue burden and, therefore, the criteria for restriction has not been satisfied (MPEP § 803).

Regarding the species election, the Restriction Requirement indicates that a species of recombinase be elected. Applicant elects the species of Cre recombinase. The Restriction Requirement additionally indicates that a species of lox cell sites be elected. Applicant elects the species of loxP site and non-identical lox sites.

The Restriction Requirement further indicates that a species of a single modified peptide encoded by a variant nucleic acid, as in claim 2, be elected. The claims are directed to cell compositions containing a diverse population of about 10 or more variant nucleic acids. With regard to species election, MPEP §806.04(f) indicates:

The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.

It is respectfully submitted that the test for a species election with regard to a single modified peptide does not apply, and

Inventor: William D. Huse
Serial No.: 09/997,209
Filed: November 28, 2001
Page 5

Applicant respectfully requests reconsideration and withdrawal of the species election for a single modified peptide.

Nevertheless, should the Examiner maintain the species election of a single modified peptide, Applicants elect a single variant having a predetermined amino acid change at a preselected position within a parent amino acid sequence.

The claims readable on the elected species of Cre recombinase are claims 1-10 of Group I, claim 11 of Group II, claims 12 and 13 of Group III, claims 14-24 of Group IV, claim 25 of Group V, and claims 26 and 27 of Group VI. The claims readable on the elected species of loxP are claims 1-10 of Group I, claim 11 of Group II, claims 12 and 13 of Group III, claims 14-24 of Group IV, claim 25 of Group V, and claims 26 and 27 of Group VI. The claims readable on the elected species of nonidentical lox site are claims 1-10 of Group I, claim 11 of Group II, claims 12 and 13 of Group III, claims 14-24 of Group IV, claim 25 of Group V and claims 26 and 27, of Group VI. Although traversed, the claims readable on the elected species of a single variant having a predetermined amino acid change at a preselected position within a parent amino acid sequence are claims 1-10 of Group I, claim 11 of Group II, claims 12 and 13 of Group III, claims 14-24 of Group IV, claim 25 of Group V, and claims 26 and 27 of Group VI.

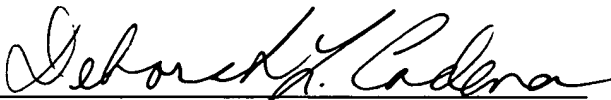
Applicant respectfully requests that the Restriction Requirement be reconsidered and that the claims of Group I be examined with the claims of Group IV. It is further requested that the claims of Groups II and III be examined with the claims

Inventor: William D. Huse
Serial No.: 09/997,209
Filed: November 28, 2001
Page 6

of Group I. It is additionally requested that the claims of Groups V and VI be examined with the claims of Group IV, should these claims be rejoined with Group I. Applicant also elects the species of Cre recombinase, loxP site and non-identical lox sites, and, if the species election is maintained, a single variant having a predetermined amino acid change at a preselected position within a parent amino acid sequence. The Examiner is invited to call the undersigned agent or Cathryn Campbell if there are any questions.

Respectfully submitted,

February 13, 2003
Date


Deborah L. Cadena
Registration No. 44,048
Telephone No.: (858) 535-9001
Facsimile No.: (858) 535-8949

CAMPBELL & FLORES LLP
4370 La Jolla Village Drive
Suite 700
San Diego, California 92122
USPTO CUSTOMER NO. 23601